

REMARKS

Claims 46-53, 56-63, 66-70, and 73-74 are presently pending.

Amendment and cancellation of certain claims is not to be construed as a dedication to the public of any of the subject matter of the claims as previously presented.

No new matter has been added.

In the Office Communication mailed October 25, 2010 as entered in the above-captioned matter, the Examiner objected to the specification and rejected claims 46-53, 56-63, and 66-72 under 35 U.S.C. 112, second paragraph. Claims 66 and 74 were rejected under 35 U.S.C. 101. Claims 46-53, 56-63, 66-67, 69, and 73-74 were rejected under 35 U.S.C. 103(a) as being unpatentable over Fujiwara et al. (U.S. 6,064,879) ("Fujiwara") in view of Lipsit (U.S. 5,956,636) (Lipsit) and further in view of Rai (U.S. 6,675,208) ("Rai"). Claims 68 and 70 were rejected under 35 U.S.C. 103(a) given Fujiwara in view of Lipsit and Rai and further in view of Bertrand et al. (U.S. 6,687,252) ("Bertrand"). The Applicants respectfully traverse these rejections and request reconsideration.

Objections to the specification

The Examiner objected to the specification as not providing antecedent support for the expression "core network." While we believe that the specification does provide adequate support for this expression, our changes to the claims pursuant to this amendment also now include deleting the expression "core network." As this expression no longer appears in the claims, we respectfully submit that the objection to the specification is obviated.

Rejections under 35 U.S.C. 112

The Examiner rejected claims 46-53, 56-63, and 66-72 under 35 U.S.C. 112, second paragraph. In particular, the Examiner expressed concern that confusion might arise

regarding the various “networks” that appear in these claims. While we respectfully disagree than any undue confusion arose in those regards, we also note that the amendments we have made to these claims pursuant to this amendment also obviate this rejection under 35 U.S.C. 112, second paragraph. In particular, the only “network” to which these claims now refer is a “Universal Mobile Telecommunications System (UMTS) access network.”

Rejections under 35 U.S.C. 101

Claims 66 and 74 were rejected under 35 U.S.C. 101. In particular, the Examiner expresses concern that the “computer readable medium” of claim 66 may be transitory in nature while claim 74 is a “device claim comprising, essentially, code only.”¹

Pursuant to this amendment, claim 66 now specifies that the computer readable medium is, in fact, “non-transitory.”

As for the rejection of claim 74, we respectfully submit that the Examiner has not presented a *prima facie* showing of a lack of patent eligibility. In particular, it is not contrary to 35 U.S.C. 101 for a “device claim” to comprise “essentially, code only.” A so-called Beauregard-style claim, for example, is exactly that; a non-transitory computer memory having code stored in it.

We have consulted the Patent Office’s current Patent Subject Matter Eligibility Examination Instructions (a copy of which we attach for the convenience of the Examiner) and can find no basis there to support this particular rejection of claim 74. While these Instructions are not a binding statement of law per se, we note that the Examiner has not cited any other support for his position that claim 74 is somehow lacking in patent eligibility.

Accordingly, we respectfully submit that claim 74 does meet the limited requirements of 35 U.S.C. 101.

¹ Aforementioned Office Action at page 4.

Rejections under 35 U.S.C. 103

Claims 46-53, 56-63, 66-67, 69, and 73-74 were rejected under 35 U.S.C. 103(a) as being unpatentable over Fujiwara in view of Lipsit and further in view of Rai. Claims 68 and 70 were rejected under 35 U.S.C. 103(a) given Fujiwara in view of Lipsit and Rai and further in view of Bertrand.

In our previous response we noted a fundamental difference between independent claim 46 and Fujiwara; in particular, that claim 46 is directed to registering a user equipment for Internet access in a UMTS wireless access network. Fujiwara, on the other hand, is directed to registering handsets for voice calls. In the "Response to Arguments" section of the Office Action the Examiner says that he accords no patentable weight to this distinction because the noted feature appears in the claim preamble. For the record, we disagree with this reading of this claim. In particular, we note that numerous elements appearing in the main body of the claim (such as "UE" and "registration server") rely for their antecedent basis upon the preamble of the claim. Accordingly, the main body of the claim relies upon the preamble for completeness and hence the preamble is, in fact, limiting.

That said, in the interests of expedited consideration we have amended the claims to specifically place this feature into the main body of each of the independent claims. Accordingly, the feature of the registration being for a user equipment to access the Internet through the Universal Mobile Telecommunications System (UMTS) access network is now clearly recited in claim 46 as a substantive limitation and hence provides a clear distinguishing feature over Fujiwara.

Fujiwara.

For a new telephone handset to be used in a radio access network it must first be associated with a unique ID number (a subscriber identity). Fujiwara is all about how to write such an ID number to a telephone handset after it has been sold. Normally this is done

by connecting the telephone handset to a ROM writer, for example at the point-of-sale. Fujiwara explains how a handset can be sold with a temporary ID to provide restricted access to the network, and how the temporary ID can be used to connect to the network so the network can assign a permanent ID to be written to the handset.

Fujiwara's process is fundamentally different from the processes described in the present application, and this is apparent from various features of claim 46 which are not disclosed in Fujiwara. However, before commenting on these specific features, we make a general comment on the approach taken in the Office Action to seek to support the rejection of obviousness.

In particular, Fujiwara describes a specific scheme for achieving a specific aim - namely writing a permanent ID into a new telephone handset. In the overall context of this scheme there are certain steps that are necessarily performed in the way Fujiwara describes and which cannot be performed in a way that could be seen as corresponding to the way certain steps are set forth in claim 46.

It is important to note that any attempt to modify Fujiwara to incorporate steps which correspond to those of claim 46 would prevent Fujiwara from operating in its intended manner. This means that even if other documents mentioned in the office action might be considered to describe steps which correspond in some ways with steps of claim 46, this does not make it obvious to modify Fujiwara to include these steps. This is because doing so would prevent Fujiwara from working as Fujiwara otherwise requires. When a proposed combination/modification will alter the operating principles of one of the references, the proposed modification/combination is not proper under 35 U.S.C. 103(a). See MPEP 2143.01 which states that "the proposed modification cannot render the prior art unsatisfactory for its intended purpose."

We further respectfully submit that to identify such concerns regarding Fujiwara is not to merely attack Fujiwara individually. In fact, we are not "attacking" it at all. We are,

however, identifying a legitimate and substantive point – the person of ordinary skill in the art will understand Fujiwara to do what he does in order to achieve certain results. This same person of ordinary skill in the art will also understand that modifying Fujiwara to include the proposed bits and pieces from the other references will stymie those results and hence will render Fujiwara unsatisfactory for its intended purpose. When such is the case, obviousness does not exist.

Moving beyond these general statements we now present certain specifics regarding the claim language.

As explained in the previous response, Fujiwara does not disclose "registering the user equipment (UE) for subsequent access to the Internet through the UMTS access network using the permanent ID and permanent password". On the contrary, Fujiwara has nothing to do with registering a UE for access to the Internet one way or the other and has nothing to do with passwords, permanent or otherwise.

Similarly, Fujiwara does not disclose "authentication by an authentication server of a temporary ID and a temporary password identifying the UE as unregistered." This is not least because there is no temporary password in Fujiwara.

Furthermore, it is not reasonable for Fujiwara's scheme to adopt anything that might be considered as corresponding to this feature even if such a feature is considered to be disclosed in another cited reference. This is because the whole context of Fujiwara concerns how a telephone handset identifies itself to the network using a temporary ID written to the handset during manufacture, and then overwrites this with a permanent network-established ID during initial registration. There is no room here for any use of a password, and attempting to introduce a password to Fujiwara will defeat or at least discourage Fujiwara's intended functionality because Fujiwara requires that the telephone handset be automatically identified by the unique temporary ID that is hardwired into the handset;

introducing a password requirement into such a context will run contrary to the presumed automated circumstances that Fujiwara identifies and relies upon.

Not only is there no need for a separate password, indeed it is not clear how a temporary password could be used in any case. For example, it is not clear who would know the temporary password, who would be supposed to enter the password, what would the password protect, and what would the password be checked against.

The simple fact is it makes no sense to suggest it would be obvious to modify Fujiwara to use a temporary password in accordance with this claim feature because the whole concept of a password does not fit in the context of what Fujiwara is all about. To somehow graft a password requirement into Fujiwara would be artificial at best and harmful to Fujiwara's operability at worst.

Another fundamental difference between claim 46 and Fujiwara is that Fujiwara also does not disclose "receiving, from the UE in response to the request for registration information, a permanent ID and a permanent password." As regards a "permanent password," similar comments to those made above in relation to the "temporary password" also apply here. That is to say, there is simply no reason to include a password in the context of Fujiwara and numerous reasons, in fact, to avoid such a configuration. This is because the right to use the telephone handset on the network is governed by physical possession of the handset, and not by any password that must be entered to access the network. (It will be appreciated that any password a user might apply to their telephone handset's operating system to prevent unauthorized use of the handset is wholly unrelated to, and clearly cannot be construed as, corresponding to the concept of a password that is used when registering for Internet access in accordance with our claims.)

As regards claim 46's specification of a "permanent ID," this is perhaps the most significant distinction from Fujiwara. This claim specifies receiving the permanent ID from the UE, i.e. the UE is responsible for establishing the permanent ID. In Fujiwara, however,

it is the network that is responsible for establishing Fujiwara's permanent ID and transmitting this to the UE (see, for example, column 4, lines 41 to 48).

In short, Fujiwara teaches the exact opposite of what claim 46 sets forth.

The office action suggests this deficiency in Fujiwara is overcome by Lipsit. This is said to be because Lipsit teaches a scheme whereby users can select their own ID and password, and so it would be obvious to do this in Fujiwara.

This line of thinking, however, completely ignores the fact that modifying Fujiwara in this way would prevent Fujiwara from working in the intended manner and from achieving its stated aims. Specifically, Fujiwara is concerned with reducing the risk of illegal duplication of mobile units by so called "cloning" (see column 1, lines 24 to 30). If a user was free to choose their own permanent ID when registering a telephone handset following the principles of Fujiwara's scheme, an unscrupulous user could use the same details for multiple telephone handsets. This is why it is fundamental to Fujiwara's scheme that the network establishes the permanent ID and transmits this to the UE, which as noted above is the complete opposite of what is recited in claim 46. For this reason alone we respectfully submit that it is wholly unrealistic to suggest that the person of ordinary skill in the art would be motivated to modify Fujiwara in ways that severely undercut Fujiwara's operating principles in order to arrive at the present invention, and this is the case regardless of the teachings of the cited art.

Because of these reasons at least, we respectfully submit that claim 46 is not rendered obvious by any fair combination of the relied-upon prior art references.

The remaining independent claims (56, 66, 67, and 69) may be similarly distinguished from these same references. For the sake of brevity we will not repeat those same points here.

The remaining claims are ultimately dependent upon one of these independent claims. While we believe that other arguments are available to highlight the allowable

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subject matter presented in various ones of these dependent claims, we also believe that the comments set forth herein regarding allowability of the independent claims are sufficiently compelling to warrant present exclusion of such additional points for the sake of brevity and expedited consideration.

CONCLUSION

We respectfully submit that claims 46-53, 56-63, 66-70, 73, and 74 are allowable over the references of record and are otherwise in suitable condition to support allowance. The case is believed to be in condition for allowance and notice to such effect is respectfully requested. If the Examiner should have any other points of concern, the Examiner is expressly invited to contact the undersigned by telephone to discuss those concerns and to seek an amicable resolution.

Respectfully submitted,
FITCH, EVEN, TABIN & FLANNERY

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